REMARKS

Applicant has studied the Office Action dated August 15, 2005, and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-22 are pending. Claims 1-3, 7-11, and 13-14 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

(page 2) rejected claims 1-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

(pages 2-6) rejected claims 1-15 and 17-22 under 35 U.S.C. § 102(e) as being anticipated by Lee et al. (U.S. Patent No. 6,779,040); and

(pages 6-7) rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) in view of Salo et al. (U.S. Patent No. 6,563,800).

(Page 2) Rejection under 35 U.S.C. §112

As noted above, the Examiner rejected claims 1-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner stated that the term "automatically determined" was not described in the specification. The Examiner continues, on page 8 of the above-identified Office Action, and states that the term "automatically determined" is not equivalent to executing a process without human intervention.

The term "automatically" has been cancelled from the claims.

The specification of the instant application recites:

> [T]he Image Format Determination Server 248 would regularly receive

> updates to the capability database 258 **via the network** 202. According to one preferred embodiment, web content servers 208 would receive communications with **networked devices** 204, 206, and collect capability information corresponding to the **networked devices** 204, 206. For example, **as the first networked device** 204 accesses **the network** 202 from varying communication links, the **changes** in communication capability **can be monitored by the web content servers** 208 **and updated** to the capability database 258 in the Image Format Determination Server 248. The image server 214, for example, would send an update message to the image proxy engine 256. The image proxy engine 256 would then accordingly update the capability database 258. Similarly, if a new presentation resource (e.g. a new display system) is being used in the first networked device 204, for example, then the image server 214 would send an update to the image proxy engine 256 to update accordingly the capability record corresponding to the first networked device 204, as stored in the capability database 258. Page 27, line 15 through page 28, line 10.

The specification of the instant application also recites:

> The request from the browsing device is augmented with information known to the server **but not part of the original request**, such as user identification and session parameters. A preferred implementation of the invention **stores information about network speed and client processing capabilities for each session between client and server.** The final request sent to the web server, contains information identifying a document that a client networked device is requesting, as well as information about network status and client networked device capabilities for the active session. Page 14, line 18 through page 15, line 5

It is therefore clear from the specification of the instant application that the image-delivery parameter is determined solely by hardware devices on the network and without the presence or need for user input. In addition, the determination is based solely on a request that includes session information pertaining to a current communication session between the networked device and a server, the session information being separate from a request for delivery of image information.

Because the term "automatically" has been removed from the claims and because the language of the newly-amended claims is properly supported in the specification of the instant application as originally filed, Applicant believes that the rejection of Claims 1-22, under 35 U.S.C. § 112, first paragraph, as discussed above, has been

overcome. Applicant kindly requests that the Examiner withdraw the rejection of Claims 1-22.

(Pages 2-6) Rejection under 35 U.S.C. §102(e) Lee et al.

As noted above, the Examiner rejected Claims 1-15 and 17-22 under 35 U.S.C. § 102(e) as being anticipated by Lee et al. (U.S. Patent No. 6,779,040).

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent Claims 1-3 recite, *inter alia*:

> ...
> receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information;
> determining, by at least one server within a network, based on an image delivery parameter and an image presentation parameter associated with the networked device, an image format for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information (emphasis added)

Amended claims 7 and 9 recite, *inter alia*:

> ...
> receiving a request that includes a request for delivery of image information to a networked client device and session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of displayable image information; and
> determining, by at least one server within a network an image format for the displayable image information from an image delivery parameter and an image presentation parameter associated with the networked client device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information (emphasis added)

Amended claim 11 recites, *inter alia*:

> ...
>
> receiving a request that includes a request for delivery of displayable image information to the networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of, the displayable image information;
>
> determining, by at least one server within a network, available image formats for the displayable image information; and
>
> selecting one of the available image formats, based at least in part on the image delivery parameter and the image presentation parameter, for delivery to and presentation at the networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information. (emphasis added)

Amended claim 13 recites, *inter alia*:

> ...
>
> receiving a request that includes a request for delivery of content information to the at least one networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of, the content information comprising image information; and
>
> determining, by at least one server within a network, based on the image delivery parameter and the image presentation parameter associated with the at least one networked device, an image format for the image information for delivery of the image information to the at least one networked device and for presentation of the image information at the at least one networked device, the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information

Lee et al. discloses a method and system for on-demand data compression of data files for transfer from a server computer to a client computer. Lee, col. 2, lines 62-63. Lee et al. discloses two types of requests: 1) a request for an image; and 2) a request to register a set of client computer capabilities and user preferences to be used for future image requests. Lee et al., col. 12, lines 14-48. Lee et al. is silent on how the client device provides parameters, and specifically, how the user-specified rules for data transmission capabilities are communicated. Regardless, the information

conveyed in Lee is always within a **request to register client computer capabilities and user preference parameters**. See Lee et al. col. 11, lines 41-47 and col. 12, line 14-48.

On the other hand, the presently claimed invention is taught in the specification, for example, as follows:

> The request from the browsing device is augmented with information known to the server but not part of the original request, such as user identification and session parameters. A preferred implementation of the invention stores information about network speed and client processing capabilities for each session between client and server. **The final request sent to the web server, contains** information identifying a document that a client networked device is requesting, as well as **information about network status and client networked device capabilities for the active session**. See the specification, page 14, line 18 through page 15, line 5.

A method according to the present invention transmits a request that is **augmented** with transmission information. The method of the present invention does not require a separate registration step because the session information, typically transmitted as part of a header of information packets transmitted across a network, contains this transmission information. As is well known in the art, headers contain session information that is separate from the information contained in the data payload portion of an information packet. With the present invention, the transmission information can be inserted as part of the session information and without the transmission information having to be included in the request itself, e.g., without having to be affirmatively requested by a request that is typically transmitted in the data payload portion of information packets transmitted across a network. The amended claims, and all dependent claims depending therefrom, respectively, now more clearly specify this difference between the present invention and the cited Lee et al reference.

Additionally, **original claim 18** (which has not been amended) is directed at a **proxy engine** that is used to determine the image format for the image information. Similarly, amended claims 8 and 14 recite a proxy server that is separate and remote from the content server located across the network and the proxy server being used to

determine an image format for the image information to be delivered to the networked device. Note that it is the proxy server (e.g., the proxy engine) that determines the image format for the image that is to be transmitted across the network to the networked device. See, for example, FIG. 2, elements 248 and 256, of the instant application. The proxy engine may be located at the same server that is in direct communication with the networked device (see FIG. 2, elements 238 and 240), or, alternatively, the proxy engine can be located at a proxy server that is separate and remote across the network from the server that is in direct communication with the networked device (see FIG. 2, elements 248 and 256). This is significantly different than the teachings of Lee.

Lee et al. do not disclose a proxy server (e.g., or a proxy engine), and certainly do not teach or suggest a proxy server, or a proxy engine, for determining image format for image information. In Lee et al., the determining is performed at the receiving server based on the information contained in the **request to register client computer capabilities and user preference parameters**. See Lee et al. col. 11, lines 41-47, and col. 12, line 14-48, and lines 52-59. Lee do not teach or suggest the determining of image format being performed with the assistance of an image format determining proxy server (e.g., proxy engine), as taught and claimed for the present inventive method and system.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Lee et al.[1] Because the elements in independent Claims 1-3, 7, 9, 11, and 13 of the instant application are not taught by Lee et al., as has been discussed above, the apparatus of Lee et al. does not teach or anticipate the present invention as claimed. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either of the

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[1] See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the.... claim."

independent claims 1, 2, 3, 7, 9, 11, or 13, respectively. Further, **original** dependent Claim 18 recites the image proxyengine for determining the image format, which is not taught or anticipated byLee, as has been discussed above. Similarly, amended dependent Claims 8 and 14 recite the determining being performed with a proxyserver that is separate and remote across the network from the server that is in direct communication with the networked device for delivering the image information to the networked device. Accordingly, in view of the amendment and remarks above, the presently claimed invention distinguishes over Lee et al. for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of these claims.

(Pages 7-8) Rejection under 35 U.S.C. §103(a) Lee et al. in view of Salo et al.

As noted above, the Examiner rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) in view of Salo et al. (U.S. Patent No. 6,563,800).

The deficiencies of Lee et al. are discussed in the preceding section entitled "Rejection under 35 U.S.C. §102(e) Lee et al." Claims 16-18 depend from independent Claim 13. Similar to Lee et al., Salo neither shows nor suggests the limitations recited in amended Claim 13 of the instant application. Further, **original** dependent Claim 18 recites the image proxy engine for determining the image format, as has been discussed above, which is not taught or anticipated by Lee, by Salo, or by any combination thereof.

It is accordingly believed to be clear that Lee et al., whether taken alone or in any combination with Salo et al. neither shows nor suggests the features of independent Claim 13. Claim 13 is, therefore, believed to be patentable over the cited prior art. Dependent Claims 16-18 are believed to be patentable as well because they all are dependent from allowable Claim 13. Further, **original** dependent Claim 18 additionally recites novel and allowable subject mater over the teachings of Lee, Salo, or any combination of the cited references.

Continuing further, when there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Lee et al. taken alone and/or in view of Salo et al. does not teach or suggest the limitations of Claim 13. Accordingly, Claims 16-18 distinguish over Lee et al. taken alone and/or in view of Salo et al. for this reason as well.

Accordingly, in view of the amendments and remarks above, since neither Lee et al., Salo et al., nor any combination of the two cited references, teaches, anticipates, or suggests, the presently claimed, for example, "determining, based on the image delivery parameter and the image presentation parameter" and "the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information", and further, as recited for dependent Claim 18, that the "image proxy engine, responsive to the API calls, for determining, based on at least one of an image delivery parameter and an image presentation parameter associated with the at least one networked device, the image format for the image information", Applicant believes that the rejection of Claims 16-18 under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claims.

CONCLUSION

The foregoing is submitted as full and complete response to the Official Action mailed August 15, 2005, and it is submitted that Claims 1-22 are in condition for allowance. Applicant requests that the Examiner enter this Response with Amendment to place the claims in allowable form, or to place the claims in better condition for appeal. Reconsideration of the rejection is requested. Allowance of Claims 1-22 is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicants acknowledge the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and the attorneys.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account **50-1556**.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

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